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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,434	09/10/2001	Peter Sauerbrei	49658-0512	1649

7590 03/03/2006  
Moser Patterson & Sheridan  
3040 Post Oak Boulevard  
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Houston, TX 77056-6582

EXAMINER

BRIER, JEFFERY A

ART UNIT PAPER NUMBER

2672

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/955,434

Applicant(s)

SAUERBREI, PETER

Examiner

Jeffery A. Brier

Art Unit

2672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-6,8-32,34-37,39-55 and 57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-32,34-37,39-55 and 57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed on 2/13/2006 has been entered.
2. In view the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility published on the USPTO website on October 26, 2005,

[http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101\\_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf)

and published in the OG 22Nov2005

<http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm>).

The following 35 USC 101 rejection is now required.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 3-6, 8-32, 34-37, 39-55, and 57 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 32, 34-37, 39-54, and 57:

These claims claim carrier wave signals as a computer readable medium because applicants specification at page 8 lines 23-25, page 9 line 3, and page 10 lines 8 and 17 defines computer readable medium as carrier wave.

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Page 8 lines 17-25 states (emphasis added with underlining):

The term "computer-readable medium" as used herein refers to any medium that participates in providing instructions to processor 204 for execution. Such a medium may take many forms, including but not limited to, non-volatile media, volatile media, and transmission media. Non-volatile media includes, for example, optical or magnetic disks, such as storage device 210. Volatile media includes dynamic memory, such as main memory 206. Transmission media includes coaxial cables, copper wire and fiber optics, including the wires that comprise bus 202. Transmission media can also take the form of acoustic or light waves, such as those generated during radio wave and infrared data communications.

Page 8 line 27 to page 9 line 4 states (emphasis added with underlining):

Common forms of computer-readable media include, for example, a floppy disk, a flexible disk, hard disk, magnetic tape, or any other magnetic medium, a CD-ROM, any other optical medium, punch cards, paper tape, any other physical medium with patterns of holes, a RAM, a PROM, and EPROM, a FLASH-EPROM, any other memory chip or cartridge, a carrier wave as described hereinafter, or any other medium from which a computer can read.

Page 9 line 26 to page 10 line 8 states:

Network link 220 typically provides data communication through one or more networks to other data devices. For example, network link 220 may provide a connection through local network 222 to a host computer 224 or to data equipment operated by an Internet Service Provider (ISP) 226. ISP 226 in turn provides data communication services through the world wide packet data communication network now commonly referred to as the "Internet" 228. Local network 222 and Internet 228 both use electrical, electromagnetic or optical signals that carry digital data streams. The signals through the various networks and the signals on network link 220 and through communication interface 218, which carry the digital data to and from computer system 200, are exemplary forms of carrier waves transporting the information.

Page 10 line 15-17 states:

The received code may be executed by processor 204 as it is received, and/or stored in storage device 210, or other non-volatile storage for later execution. In this manner, computer system 200 may obtain application code in the form of a carrier wave.

Therefore, the specification defines computer readable medium as a carrier wave.

Thus, when the claims are read in light of the specification claims 32, 34-37, 39-54, and 57 claim a carrier wave computer readable medium. In ANNEX IV Computer-Related Nonstatutory Subject Matter of the Interim guidelines a signal is held to be nonstatutory subject matter and since applicants carrier wave is a signal then these claims are nonstatutory.

Means plus function claim 57 is included because the means in the claim, in view of the specification, is the computer readable medium which has been defined as a carrier wave which is a signal.

Claims 1, 3-6, 8-32, 34-37, 39-55, and 57:

These claims fail to claim a useful, tangible, and concrete result. The claim as a whole and the last step of claims 1, 32, 55, and 57 "mapping the set of points to the defined constraint to establish location of the objects relative to said constraint" does not manifest a useful, tangible, and concrete result. Thus, these claims as well as their dependent claims need an additional step (or means plus function step in claim 57) that manifest a useful, tangible, and concrete result. The specification at page 32 line 26 to page 33 line 2 states:

At step 814, the constraint is displayed and objects placed onto the constraint at the object locations that were determined in step 812. In other embodiments, the objects are not displayed on the constraint. For example, the generated set of points may be returned to a unit of software that is interfacing with the spacing mechanism

Thus, a display step would be one way applicant could meet the useful, tangible, and concrete result requirement.

Claim 57:

This claim is additionally nonstatutory because this means plus function claim has its "means", due to alternative definitions in the specification, as being software or software module which is nonstatutory since a program per se is not statutory.

Applicants specification at page 8 lines 13-16 defines software as an alternative to hardware and as an alternative to hardware and software combination and states:

In alternative embodiments, hard-wired circuitry may be used in place of or in combination with software instructions to implement the invention. Thus, embodiments of the invention are not limited to any specific combination of hardware circuitry and software.


Applicant should note that amendments to the specification, such as deletion, may introduce new matter into the specification. Thus, an appropriate amendment to the claims is necessary to make the claims statutory.

***Allowable Subject Matter***

5. Claims 1, 3-6, 8-32, 34-37, 39-55 and 57 would be allowable if the claims can be amended to overcome the 35 USC 101 nonstatutory rejection. Applicant remarks concerning Takakura et al. at pages 14-16 of the 9/27/2005 response are persuasive to overcome the 103 rejection of Asente in view of Takakura et al.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:00 to 3:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jeffery A Brier  
Primary Examiner  
Art Unit 2672  
